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EXAMINER

GELAGAY, SHEWAYE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNARDO A HUMBERMAN, STEPHEN P. SORKIN
and JOSHUA R. TYLER

Appeal 2010-001515
Application 10/695,198
Technology Center 2400

Before DALE M. SHAW, *Support Division 2 Administrator*

ORDER RE-MAILING BOARD DECISION

This appeal was decided on Wednesday, May 2, 2012 (*see* attached copy of the Decision). However, the incorrect Decision was inadvertently mailed to Appellants. Accordingly, the correct Decision is being re-mailed.

Appellant's time for seeking rehearing under 37 CFR 41.52(a)(1)

Appeal 2010-001515
Application 10/695,198

expires two (2) months from the entry date of this Order.

If there are any questions pertaining to this Order, please contact
Board of Patent Appeals and Interferences at 571-272-9797.

DMS/lae

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SORKIN, and JOSHUA R. TYLER

Appeal 2010-001515
Application 10/695,198
Technology Center 2400

Before LANCE LEONARD BARRY, JOHN A. JEFFERY, and THU A.
DANG, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

The Patent Examiner rejected claims 1-6, 10-18, 20-25, 27, and 29. Claims 8, 9, 19, and 28 have been indicated as containing allowable subject matter. (Ans. 13.) The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

Claim 1, which follows, is illustrative of the claimed subject matter.

1. A method usable on a first communication device adapted to communicate with a second communication device, comprising:
 - obtaining a first key;
 - encoding an attribute in the first communication device with the first key to produce a first encoded value;
 - transmitting the first encoded value to the second communication device;
 - receiving a second encoded value from the second communication device, the second encoded value comprising an attribute stored in the second communication device that has been encoded with a second key associated with the second communication device;
 - encoding the second encoded value with the first key to produce a third encoded value;
 - transmitting the third encoded value to the second communication device;
 - receiving a fourth encoded value from the second communication device, the fourth encoded value comprising the first encoded value after being encoded by the second key; and
 - if the third encoded value matches the fourth encoded value, adjusting a total number of matches; and
 - enabling users of the first and second communication devices to physically locate one another only if said total number of matches meets or exceeds a threshold;
 - wherein the first and second communication devices comprise mobile communication devices.

REFERENCES AND REJECTIONS

Doub	US 6,594,762	Jul. 15, 2003
Drutman	US 6,618,593 B1	Sep. 9, 2003
Yeager	US 2004/0133640 A1	Jul. 8, 2004
Zacks	US 2004/0192383 A1	Sep. 30, 2004

Bernardo A. Huberman et al., "Enhancing Privacy and Trust in Electronic Communities" ACM, 78-86 (1999).

Claims 1-6, 10-18, 20, 21, 24 and 27 stand rejected under 35 U.S.C §103(a) as being unpatentable over Huberman and Drutman.

Claims 22, 23, and 25 stand rejected under 35 U.S.C §103(a) as being unpatentable over Huberman, Drutman, and Yeager.

Claim 29 stands rejected under 35 U.S.C §103(a) as being unpatentable over Huberman, Drutman, and Doub.

DISCUSSION

Based on the Appellants' arguments, we will decide the appeal of claims 1-6, 10-18, and 20-23 on the basis of claim 1 and the appeal of claims 24, 25, and 27 on the basis of claim 24. We will address claim 29 separately. Therefore, the issues before us follow.

Did the Examiner err in finding that the combined teachings of Huberman and Drutman would have suggested "enabling users of . . . first and second communication devices to physically locate one another only if [a] total number of matches meets or exceeds a threshold," as required by representative claim 1?

Did the Examiner err in finding that the combined teachings of Huberman and Drutman would have suggested "designat[ing] a subset of [a] first plurality of attributes as information that may always, occasionally or never be revealed to [a] second communication device," as required by representative claim 24?

Did the Examiner err in finding that Doub teaches a signal "indicative of . . . separation" of the first and second communication devices, as required by claim 29?

We address the issues *seriatim*.

CLAIMS 1-6, 10-18, and 20-23

The Appellants argue that "while Drutman's teenage dating example involves a threshold based on qualities, the claimed threshold is based on quantity." (Reply Br. 2.)

"The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art." *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *Keller*, 642 F.2d at 425). In determining obviousness, furthermore, a reference "must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole." *Id.*

Here, the Examiner's rejection is based on the combined teachings of Huberman and Drutman. We agree with the Examiner's finding that Huberman teaches that "[e]ach party now can count matches. Alice and Bob got to learn exactly which elements they have in common and not just how

many. (see . . . page 85, *A. Cryptographic Details and Private Preference Matching*)." (Ans. 15.) The number of matches constitutes a quantity.

The Examiner's finding that "[i]n [Drutman's] case a threshold was set (*female and religious background*) and upon finding all matches (*meeting a threshold*) the seeking male teenager receives location information (*physically locate*)" (*id.* at 17-18) is uncontested.

The Appellants cannot establish non-obviousness by attacking Huberman and Drutman individually where the rejection is based upon the teachings of the combination of the references. Rather than arguing the rejections of claims 22 and 23 separately, the Appellants rely on the aforementioned argument, which was unpersuasive.

Therefore, we conclude that the Examiner did not err in finding that the combined teachings of Huberman and Drutman would have suggested "enabling users of . . . first and second communication devices to physically locate one another only if [a] total number of matches meets or exceeds a threshold," as required by representative claim 1.

CLAIMS 24, 25, AND 27

[A]ll that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132. As the statute itself instructs, the examiner must "notify the applicant," "stating the reasons for such rejection," "together with such information and references as may be useful in judging the propriety of continuing prosecution of his application." 35 U.S.C. § 132.

In re Jung, 637 F.3d 1356, 1363 (Fed. Cir. 2011).

Here, the Examiner makes the following "specific fact finding," *Ex parte Belinne*, No. 2009-004693, 2009 WL 2477843, at *4 (BPAI Aug. 10, 2009) (informative).

Huberman discloses a procedure that allows for a group of individuals to privately search for others with similar preferences while keeping the preferences private. Further, Drutman discloses that the male teenager may receive the location and/or the personal information of the matching female teenager. Alternatively, the matching female teenager may also receive the location and/or preferences data of the requesting male teenager. Therefore, the combination of Huberman and Drutman teaches designate attributes as information that may always, occasionally or never be revealed to the second device.

(Ans. 19.)

For their part, the Appellants do not address these findings. Instead, they merely allege that they "have not found the designation of 'a subset of the first plurality of attributes as information that may always, occasionally or never be revealed to the second communication device,' as claimed, in any of the cited references." (Reply Br. 3-4.) This allegation "do[es] not . . . explain why the Examiner's explicit fact finding is in error." *Belinne*, 2009 WL at *4." Rather than arguing the rejection of claim 25 separately, the Appellants rely on the aforementioned argument, which was unpersuasive.

Therefore, we conclude that the Examiner did not err in finding that the combined teachings of Huberman and Drutman would have suggested "designat[ing] a subset of [a] first plurality of attributes as information that may always, occasionally or never be revealed to [a] second communication device," as required by representative claim 24.

CLAIM 29

The Appellants argue that "Doub's reply signal is not 'indicative of said separation,'" (Appeal Br. 19.) We agree, however, with the Examiner's following claim interpretation and findings.

Appellant's originally filed specification on paragraph [0031] discloses that "In this case, if, during the matching process, the distance between communication devices A and B increases due to relative movement of the devices A, B beyond the maximum distance permitted by local communication interfaces 102A and 102B, communication devices A and B may display a 'failure' message on their display devices 104A and 104B." Consistent with the Appellant's teaching, Doub discloses the display of the electronic device may be enabled when the electronic device and the remote device are located within a first distance and the display device is disabled when the remote device is located a second distance from the remote device, wherein the second distance is greater than the first distance. Therefore, Doub discloses if the first communication device is physically separated from the second device by a predetermined distance (*i.e. a second distance which is greater than the first distance*), the first communication device generates a message indicative of said separation (*i.e. disabling the display device*).

(Ans. 20.)

Therefore, we conclude that the Examiner did not err finding that Doub teaches a signal "indicative of . . . separation" of the first and second communication devices, as required by claim 29.

DECISION

We affirm the rejection of claims 1 and 24 and those of claims 2-6, 10-18, 20-23, 25, and 27, which fall therewith. We also affirm the rejection of claim 29.

Appeal 2010-001515
Application 10/695,198

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb